



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/579,029

11/19/2008

Christopher K. Raymond

ROSA127563

2231

26389

7590

06/24/2009

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

EXAMINER

MUMMERT, STEPHANIE KANE

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,029	Applicant(s) RAYMOND, CHRISTOPHER K.	
	Examiner STEPHANIE K. MUMMERT	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 25-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/7/06;10/23/08;11/26/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-24, drawn to a method for amplifying microRNA.

Group II, claim(s) 25-42, drawn to a kit comprising a primer set or individual primers.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The groups are not linked by a special technical feature which distinguishes over the art. For example, the method of claim 1 requires producing a first DNA molecule that is complementary to a target using primer extension and amplifying the first DNA molecule using a universal forward and reverse primer. These elements of the claim do not distinguish over the art because the prior art, including Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information) and Spivack et al. (US PgPub 2003/0186288; October 2003) render the combination of elements obvious, particularly for the intended use of amplifying microRNA (p. 862, col. 1, 23, where the cDNA was amplified using primers corresponding to the adaptor sequences, as evidenced by p. 4 of supplemental

Art Unit: 1637

information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor).

During a telephone conversation with Tineka Quinton on June 17, 2009 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

Art Unit: 1637

amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant's election without traverse of Group I, claims 1-24 is acknowledged.

Claims 25-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 1-24 are pending and will be examined.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on December 7, 2006; October 23, 2008; and November 26, 2008 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See embedded hyperlink on page 6, line 27 and on page 13, line 18.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 10, 15, 18, 20 are anticipated under 35 USC 102(b) as being anticipated by Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information). Lau teaches detection of microRNA through amplification.

With regard to claim 1, Lau teaches a method for amplifying a microRNA molecule to produce DNA molecules, the method comprising the steps of:

(a) producing a first DNA molecule that is complementary to a target microRNA molecule using primer extension (p. 862, col. 1, 23, where the size fractionated RNAs are ligated with 3' adaptor using T4 RNA ligase, followed by ligating a 5' adaptor and the ligation products were reverse transcribed resulting in cDNA, see p. 4 supplemental information); and

(b) amplifying the first DNA molecule to produce amplified DNA molecules using a universal forward primer and a reverse primer (p. 862, col. 1, 23, where the cDNA was amplified using primers corresponding to the adaptor sequences, as evidenced by p. 4 of supplemental information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor).

With regard to claim 3, Lau teaches an embodiment of claim 1 wherein the primer extension uses an extension primer having a length in the range of from 10 to 100 nucleotides or

Art Unit: 1637

20 to 35 nucleotides (p. 862, col. 1, 23 and as evidenced by supplemental information, p. 4, where the extension primer/reverse primer is 17 nucleotides in length).

With regard to claim 10, Lau teaches an embodiment of claim 1 wherein the universal forward primer has a length in the range of from 16 nucleotides to 100 nucleotides (p. 862, col. 1, 23 and as evidenced by supplemental information, p. 3, where the universal forward primer is 17 nucleotides in length).

With regard to claim 15, Lau teaches an embodiment of claim 1 wherein the reverse primer has a length in the range of from 10 nucleotides to 100 nucleotides (p. 862, col. 1, 23 and as evidenced by supplemental information, p. 4, where the extension primer/reverse primer is 17 nucleotides in length).

With regard to claim 18, Lau teaches an embodiment of claim 1 wherein the reverse primer is selected to specifically hybridize to a DNA molecule complementary to a selected microRNA molecule under defined hybridization conditions (p. 862, col. 1, 23, where the size fractionated RNAs are ligated with 3' adaptor using T4 RNA ligase, followed by ligating a 5' adaptor and the ligation products were reverse transcribed resulting in cDNA, see p. 4 supplemental information).

With regard to claim 20, Lau teaches an embodiment of claim 1 wherein amplification is achieved by multiple successive PCR reactions (p. 862, col. 1, 23, where the cDNA was amplified using primers corresponding to the adaptor sequences, as evidenced by p. 4 of supplemental information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor).

Art Unit: 1637

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 13-14, 16-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information) as applied to claims 1, 3, 10, 15, 18, 20 above and further in view of Braasch et al. (Chemistry & Biology, 2001, p. 1-7). Lau teaches microRNA expression detection using amplification (Abstract).

With regard to claim 2 and 22, Lau teaches an embodiment of claim 1 and 21, wherein at least one of the universal forward primer and the reverse primer (p. 862, col. 1, 23, where the cDNA was amplified using primers corresponding to the adaptor sequences, as evidenced by p. 4 of supplemental information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor)

With regard to claim 13-14, Lau teaches an embodiment of claim 2 and 13, wherein the universal forward primer (p. 862, col. 1, 23, where the cDNA was amplified using primers corresponding to the adaptor sequences, as evidenced by p. 4 of supplemental information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor).

With regard to claim 16-17, Lau teaches an embodiment of claim 2 and 16, wherein the reverse primer (p. 862, col. 1, 23, where the cDNA was amplified using primers corresponding to

Art Unit: 1637

the adaptor sequences, as evidenced by p. 4 of supplemental information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor).

Regarding claim 2, 13-14, 16-17 and 22, Lau does not teach that the primer, either the forward or reverse comprise a locked nucleic acid molecule. Braasch teaches primers and complementary sequences comprising locked nucleic acids (Abstract).

With regard to claims 2, 13, 16 and 22, Braasch comprises at least one locked nucleic acid molecule (Figure 1, where the locked nucleic acid structure is provided).

With regard to claims 14 and 17, Braasch teaches wherein the primer comprises from 1 to 25 locked nucleic acid molecules (Figure 1, where the locked nucleic acid structure is provided).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have extended the teachings of Lau and Spivack to include the locked nucleic acids of Braasch to arrive at the claimed invention with a reasonable expectation for success. As taught by Braasch, "locked nucleic acid is an RNA derivative in which the ribose ring is constrained by a methylene linkage between the 2' oxygen and the 4' carbon" and "increases binding affinity for complementary sequences and provides an exciting new chemical approach for the control of gene expression and optimization of microarrays" (Abstract).

Braasch also teaches, "LNAs possess extraordinarily high affinities for complementary sequences and forcefully suggest that LNAs have the potential to be improved agents for oligonucleotide arrays" (p. 6, col. 2). Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to have extended the teachings of Lau and Spivack to include the locked nucleic acids of Braasch to arrive at the claimed invention with a reasonable expectation for success.

Art Unit: 1637

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information)

With regard to claim 4, Lau teaches an embodiment of claim 1 wherein the primer extension uses an extension primer having a length in the range of from 20 to 35 nucleotides (p. 862, col. 1, 23 and as evidenced by supplemental information, p. 2, where the extension primer is 17 nucleotides in length).

While Lau teaches primers 17 nucleotides in length, an ordinary practitioner would have recognized that the results optimizable variables of time, product amount and primer length could be adjusted to maximize the desired results. As noted in *In re Aller*, 105 USPQ 233 at 235,

More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

Routine optimization is not considered inventive and no evidence has been presented that the primer length was other than routine, that the products resulting from the optimization have any unexpected properties, or that the results should be considered unexpected in any way as compared to the closest prior art.

Claims 5-7, 12, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information) as applied to claims 1, 3, 10, 15, 18, 20 above and further in view of Spivack et al. (US PgPub 2003/0186288; October 2003).

Art Unit: 1637

With regard to claim 7, Lau teaches an embodiment of claim 5 wherein the extension primer comprises a second portion (p. 862, col. 1, 23, where the RT primer is complementary to the adaptor, which is a second portion).

With regard to claim 8, Lau teaches an embodiment of claim 7 wherein the second portion has a length of from 18 to 25 nucleotides (p. 862, col. 1, 23 and as evidenced by supplemental information, p. 4, where the extension primer/reverse primer is 17 nucleotides in length).

With regard to claim 12, Lau teaches an embodiment of claim 7 wherein the universal forward primer hybridizes to the complement of the second portion of the extension primer (p. 862, col. 1, 23, where the 'universal' forward primer is complementary to the adaptor, which is a second portion).

With regard to claim 21, Lau teaches a method for measuring the amount of a target microRNA in a sample from a living organism, the method comprising the step of measuring the amount of a target microRNA molecule in a multiplicity of different cell types within a living organism, wherein the amount of the target microRNA molecule is measured by a method comprising the steps of:

- (1) producing a first DNA molecule complementary to the target microRNA molecule in the sample using primer extension (p. 862, col. 1, 23, where the size fractionated RNAs are ligated with 3' adaptor using T4 RNA ligase, followed by ligating a 5' adaptor and the ligation products were reverse transcribed resulting in cDNA, see p. 4 supplemental information);
- (2) amplifying the first DNA molecule to produce amplified DNA molecules using a universal forward and a reverse primer (p. 862, col. 1, 23, where the cDNA was amplified using primers

Art Unit: 1637

corresponding to the adaptor sequences, as evidenced by p. 4 of supplemental information where cDNA was amplified using the original RT primer and a primer complementary to the 5' adaptor).

Regarding claim 5-8, 12, Lau does not teach that the extension primer comprises a first portion that hybridizes to the target microRNA. Regarding claims 19 and 21, Lau does not explicitly teach measuring the amount of amplified DNA molecules.

With regard to claim 5, Spivack teaches an extension primer that comprises a first portion that hybridizes to the target microRNA (Figure 6 and 7, where the cDNA extension primer comprises a tag sequence with a unique sequence).

With regard to claim 6, Spivack teaches an embodiment of claim 25, wherein the first portion of the extension primer has a length in the range of from 3 to 25 nucleotides (paragraph 20, where the universal primer comprises 18 bp).

With regard to claim 19 and 21, Spivack teaches an embodiment of claim 1 or 21, further comprising the step of measuring the amount of amplified DNA molecules (paragraph 95-96, where the amplification products are subjected to agarose or polyacrylamide gel electrophoresis and stained to measure the density of the amplification product, or alternatively the primers are labeled with a fluorescent moiety; see also paragraph 36 and 43, where the samples are measured using Lightcycler as depicted in Figures 4A/B and Figures 10A/B respectively).

With regard to claim 23, Spivack teaches an embodiment of claim 21, wherein the amount of the amplified DNA molecules are measured using fluorescence-based quantitative PCR (paragraph 95-96, where the amplification products are subjected to agarose or polyacrylamide gel electrophoresis and stained to measure the density of the amplification

Art Unit: 1637

product, or alternatively the primers are labeled with a fluorescent moiety; see also paragraph 36 and 43, where the samples are measured using Lightcycler as depicted in Figures 4A/B and Figures 10A/B respectively).

With regard to claim 24, Spivack teaches an embodiment of claim 21, wherein the amount of the amplified DNA molecules are measured using SYBR green dye (paragraph 95-96, where the amplification products are subjected to agarose or polyacrylamide gel electrophoresis and stained to measure the density of the amplification product, and where the stain includes SYBR green dye).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the teachings of Lau to include both a tag sequence and a portion specific to the target as taught by Spivack to arrive at the claimed invention with a reasonable expectation for success. As taught by Spivack, “The present invention relates to ‘Universal RT-coupled PCR’, a novel PCR strategy that takes advantage of the poly-A tail of processed mRNA, and uses novel ‘Universal RT primers’ that comprise a unique 5’ tag sequence that does not occur in the genome of the organism being studied (for example the human genome), a poly-T midsection, and a 3’ anchor to avoid slippage. These 5’ tag-enhanced ‘Universal RT primers’ reliably initiate reverse transcription, and the unique sequence of the 5’ tag is then targeted by the PCR primers (paragraph 53)”. Spivack also teaches “the novel Universal RT primer used for reverse transcription has a 3’ three-base anchor that allows the primer to be positioned on the last 3 bases of the transcript specific sequence and covers all possible combinations of the coding 3’ end of the mRNA transcript (see FIGS. 6 and 7). This allows RNA binding without slippage, and thereby avoids the generation of cDNA's of various

Art Unit: 1637

sizes” (paragraph 58). In comparison, Lau teaches ligation of adaptors to cDNAs, and the extension primer is complementary to the adaptor. While Lau exemplifies using a reverse primer as the extension primer used to generate the cDNA, it would have been *prima facie* obvious, particularly in view of the adaptors, to use either a primer directed to the forward adaptor or to the reverse adaptor as the “universal” extension primer. Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to have adjusted the teachings of Lau to include both a tag sequence and a portion specific to the target as taught by Spivack to arrive at the claimed invention with a reasonable expectation for success.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information) as applied to claims 1, 3, 10, 15, 18, 20 above and further in view of Spivack et al. (US PgPub 2003/0186288; October 2003).

With regard to claim 8, Lau teaches an embodiment of claim 7 wherein the second portion has a length of from 18 to 25 nucleotides (p. 862, col. 1, 23 and as evidenced by supplemental information, p. 4, where the extension primer/reverse primer is 17 nucleotides in length).

While Lau teaches primers 17 nucleotides in length, an ordinary practitioner would have recognized that the results optimizable variables of time, product amount and primer length could be adjusted to maximize the desired results. As noted in *In re Aller*, 105 USPQ 233 at 235,

More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

Routine optimization is not considered inventive and no evidence has been presented that the primer length was other than routine, that the products resulting from the optimization have any unexpected properties, or that the results should be considered unexpected in any way as compared to the closest prior art.

Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (Science, 2001, vol. 294, p. 858-862 as evidenced by Lau Supplemental Information) in view of Spivack et al. (US PgPub 2003/0186288; October 2003) as applied to claims 5-8, 12, 19 and 21 above and further in view of Crollius et al. (Nature Genetics, 2000, 25(2):235-238) and Buck et al. (Biotechniques, 1999, 27:528-536).

Lau in view of Spivack render obvious the limitations of claims 5-8, 12, 19 and 21 as recited in the obviousness rejection above. However, neither Lau or Spivack teach SEQ ID NO:1 or 13.

With regard to claim 9 and 11, Crollius teaches an embodiment of claim 7 and 1, wherein the second portion of the extension primer has a nucleic acid sequence comprising the nucleic acid sequence of SEQ ID NO:1 and wherein the universal forward primer consists of the nucleic acid sequence set forth in SEQ ID NO:13 (see alignment below, where AL302487 of Crollius teaches a sequence which comprises SEQ ID NO:1 or 13, and where the sequences are the same, as evidenced by sequence listing).

```
QY          1 CATGATCAGCTGGGCCAAGA 20
              |||
Db          699 CATGATCAGCTGGGCCAAGA 680
```

Art Unit: 1637

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the teachings of Barad and Spivack to use a variety of adaptor/primer tag sequences, including the sequence comprising SEQ ID NO:1 and 13 as taught by Roest in view of Buck. Regarding the universal tag, Spivack teaches, “The present invention relates to ‘Universal RT-coupled PCR’, a novel PCR strategy that takes advantage of the poly-A tail of processed mRNA, and uses novel ‘Universal RT primers’ that comprise a unique 5’ tag sequence that does not occur in the genome of the organism being studied (for example the human genome), a poly-T midsection, and a 3’ anchor to avoid slippage. These 5’ tag-enhanced ‘Universal RT primers’ reliably initiate reverse transcription, and the unique sequence of the 5’ tag is then targeted by the PCR primers (paragraph 53)”. While Crollius' sequences puffer fish genomes, it would have been *prima facie* obvious to one of ordinary skill in the art to have included a variety of adaptor/primer tag sequences. Furthermore, in view of the guidance by Spivack that the unique sequence does not occur in the genome of the organism being studied, choosing a sequence from an unrelated organism like the *Tertraodon nigroviridis* falls in line with the teachings of Spivack. Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to have adjusted the teachings of Barad and Spivack to use a variety of adaptor/primer tag sequences, including the sequence comprising SEQ ID NO:1/13 as taught by Roest in view of Buck.

Regarding Buck, in the recent court decision *In Re Deuel* 34 USPQ 2d 1210 (Fed. Cir. 1995), the Court of Appeals for the Federal Circuit determined that the existence of a general method of identifying a specific DNA does not make the specific DNA obvious. Regarding structural or functional homologs, however, the Court stated,

Art Unit: 1637

"Normally, a *prima facie* case of obviousness is based upon structural similarity, i.e., an established structural relationship between a prior art compound and the claimed compound. Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties (see page 9, paragraph 4 of attached ref)."

Since the claimed primers simply represent structural homologs, which are derived from sequences suggested by the prior art as useful for primers and probes for the detection of puffer fish genome, and concerning which a biochemist of ordinary skill would attempt to obtain alternate compounds with improved properties, the claimed primers and probes are *prima facie* obvious over the cited references in the absence of secondary considerations.

Buck expressly provides evidence of the equivalence of primers. Specifically, Buck invited primer submissions from a number of labs (39) (page 532, column 3), with 69 different primers being submitted (see page 530, column 1). Buck also tested 95 primers spaced at 3 nucleotide intervals along the entire sequence at issue, thereby testing more than 1/3 of all possible 18-mer primers on the 300 base pair sequence (see page 530, column 1). When Buck tested each of the primers selected by the methods of the different labs, Buck found that EVERY SINGLE PRIMER worked (see page 533, column 1). Only one primer ever failed, No. 8, and that primer functioned when repeated. Further, EVERY SINGLE CONTROL PRIMER functioned as well (see page 533, column 1). Buck expressly states "The results of the empirical sequencing analysis were surprising in that nearly all of the primers yielded data of extremely high quality (page 535, column 2)." Therefore, Buck provides direct evidence that all primers would be expected to function, and in particular, all primers selected according to the ordinary criteria, however different, used by 39 different laboratories. It is particularly striking that all 95 control primers functioned, which represent 1/3 of all possible primers in the target region. This clearly shows that every primer would have a reasonable expectation of success.

Art Unit: 1637

Conclusion

No claims are allowed. All claims stand rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHANIE K. MUMMERT whose telephone number is (571)272-8503. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephanie K. Mummert/
Examiner, Art Unit 1637

SKM